

REMARKS

In the Office Action mailed the Examiner noted that claims 1-22 were pending, and rejected claims 1-22. Claims 1, 8, 12, 15, 19 and 22 have been amended, and new claims 22-23 have been added and, thus, in view of the forgoing claims 1-22 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections are traversed below.

The Examiner objected to the Abstract and the Abstract has been amended.

The Examiner objected to the claims on page 2 of the Action and the claims have been amended accordingly. Withdrawal of the objection is requested.

The Examiner rejected claims 1, 8, 15 and 22 under 35 USC section 112 as failing to comply with the enablement requirement regarding "when a note is inserted (entered) onto a document." The Examiner is requested to review application page 1, line 19 through page 2, line 6 where a description addressing the Examiner's concern can be found describing that notes can be made in the margin of the document in meetings. It is submitted that this describes when notes are inserted. Withdrawal of the objection and rejection are requested.

In the Office Action the Examiner rejected claims 1-22 under 35 U.S.C. section 112 paragraph 2 as indefinite. With respect to claims 6, 13 and 20 it is submitted that those of ordinary skill in the art understand that a printed image can be generated from an electronic document using a readily available tool, such as Microsoft Word. It is submitted that the phrase is definite to a person of skill in the art. The remaining claims have been amended in consideration of the Examiner's comments and it is submitted they satisfy the requirements of the statute. If additional concerns with the claims arise, the Examiner is invited to telephone to resolve the same. Suggestions by the Examiner are also welcome. Withdrawal of the rejection is requested.

On page 4 of the Office Action the Examiner rejected all claims under 35 U.S.C. § 102(e) as anticipated by Ching.

The present invention is directed at a system that allows a user to print out an electronic document, make handwritten notes on the paper document, pass the document with the notes around to others at a meeting where they can add notes if desired, have the paper document including the notes scanned-in, and then extract the notes and link the notes to the original electronic document.

Ching is directed to a system that allows a purchaser to track purchases using a purchase receipt that may include hand written notes using a computer system of the purchaser.

The seller prints out the receipt. The receipt can then be scanned using a computer of the purchaser. The electronic version of the original document is not involved as it is not provided to the purchaser. The receipt includes: a data form area where machine readable encoded transaction data is printed (no human readable data is in this area), a human readable area where the transaction identifying and description data is printed, such as purchased item and cost, and a region where the purchaser can write notes on the receipt. The receipt is scanned and the transaction data is decoded stored in a database on the purchaser's computer. The entire image of the receipt can also be stored with the image indexed to the transaction data decoded from the receipt and stored in the database.

This is in contrast to the present invention where the original electronic document exists and part of the scanned document, the added notes, are stored with the stored notes linked to the original electronic document. This approach provides distinct advantages over the approach of Ching. For example because the original document is available it can be changed, something not possible in Ching. Further, the present invention saves storage space by storing the notes, rather than the entire scanned document as in Ching. Additionally, there is no need to scan and decode any identifying information in the present invention as there is in Ching because the identifying information for the electronic document already exists. Ching is not particularly relevant to the present invention.

It is submitted that the present claimed invention of the independent claims patentably distinguishes over Ching and withdrawal of the rejection is requested.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claim 5 calls for searching the note. Ching allows searching of the decoded data form transaction information or for certain symbols that start and end the data form region (see col. 13, lines 28-44 and figure 7). It is submitted that the dependent claims are independently patentable over the prior art.

New claims 23 and 24 emphasize the scanning of the note altered document and the linking of the notes to the original electronic document. It is submitted that these claims distinguish over Ching.

It is submitted that the claims satisfy the requirements of 35 U.S.C. section 112. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The

claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

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By: _____



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